

### **REMARKS**

This Amendment is submitted in response to the January 16, 2007 Office Action issued by the United States Patent and Trademark. Applicant has hereinabove cancelled without prejudice the previously pending claims and has added new claims 22-26. No new matter has been added by this Amendment.

### **Restriction Requirement**

Applicant acknowledges that the Examiner has made final the requirement for restriction. Applicant points out that new claims 22-26 correspond to method of use claims which had been classified by the Examiner as belonging to Group I. Accordingly, applicant respectfully submits that new claims 22-26 do not conflict with the Examiner's requirement for restriction.

### **Rejection of Claims Under 35 U.S.C. § 102(b) and/or § 103(a)**

In the January 16, 2007 Office Action, the Examiner rejected the pending claims under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) citing U.S. Patent No. 5,843,215 (hereinafter "Whalon"). Applicant respectfully traverses this rejection and provides in more detail below the sharp contrast between Whalon and the presently pending claims.

Without conceding the bases for the Examiner's rejections, applicant has hereinabove cancelled without prejudice the previously pending claims and has submitted new claims 22-26. New claim 22 is the only currently pending independent claim and recites:

A method of preserving a beverage product comprising adding to said beverage product a preservative composition which comprises from about 0.5% to about 15% monohydric alcohol, from about 0.5% to about 20% d-limonene, and from about 0.005% to about 5.0% wax or wax extract, all of which percentages are expressed by weight of the preservative composition prior to diluting the

preservative composition or converting the preservative composition to a non-liquid form.

Whalon cannot anticipate or render obvious independent claim 22 because, *inter alia*, it does not disclose, teach or suggest a method of preserving a beverage product by adding to such product a preservative composition comprising the specifically recited combination of ingredients in the specifically recited amounts. More specifically, Whalon cannot anticipate independent claim 22 because Whalon does not disclose each and every element contained therein. Whalon cannot render obvious independent claim 22 because (1) the Examiner has not made out a *prima facie* case of obviousness; (2) a *prima facie* case of obvious cannot be made since there is no teaching or suggestion in Whalon (or elsewhere) that would motivate a person skilled in the art to modify the reference to arrive at the invention recited in claim 22 and the reference actually teaches away from the claimed invention; and (3) even if a *prima facie* case of obviousness could be made against claim 22, it would be rebutted by unexpected results described below.

In contrast to new independent claim 22, Whalon is directed to coating compositions for flexible packaging material such as paper-board, plastic wraps and tin foils. These coating compositions are described as being useful for the prevention of insect infestation in food products. (*See, e.g., Col. 1. lines 5-18.*) In sharp contrast, applicant's presently claimed invention is directed to methods of preserving beverage products against, for example, spoilage due to yeast. (*See, e.g., Examples 1-6 on pages 14-16 of the specification.*) Thus, applicant's preservative compositions are used in beverage products which are intended for consumption, whereas Whalon's compositions are used as coatings for materials which are not intended for

consumption. Whalon's compositions are simply used to coat materials to keep insects away from certain, non-beverage products.

Further, Whalon only mentions using a monohydric alcohol, d-limonene and wax in the same composition for use as a print varnish. Whalon expressly defines "print varnishes" as "clear polymers used to coat paper products, including flexible packaging." (*See* Col. 1, lines 59-64 and Examples 1 and 3.) Thus, the print varnish compositions (1) are not used in beverages; and (2) are not intended for consumption.

In addition, Whalon states that d-limonene should be included in an amount that does not exceed 0.3% of the print varnish composition. In fact, Whalon's Examples 1 and 3 and the tables included in claims 4, 6 and 13, state that d-limonene should be included in an amount that ranges from 0.01-0.28% and that d-limonene, pinene and cineole together should not exceed 0.3% of the weight of the print varnish composition. In contrast, independent claim 22 states that d-limonene will be present in a weight percent amount between about 0.5% and about 20%. Thus, the minimum amount recited in independent claim 22 is nearly twice as high as the maximum amount described by Whalon.

Moreover, although the Examiner pointed to Col. 6, lines 7-18 to support her position that Whalon describes the use of greater than 0.3% d-limonene, a closer inspection of that portion of Whalon shows that the Examiner's conclusions were misplaced for at least two reasons. First, that portion of Whalon does not refer to d-limonene, but rather the total amount of active ingredients. (*See* Col. 5, line 64 – Col. 6, line 15.) Second, Whalon describes the disadvantages of using active ingredients at a level greater than 0.3%. Such disadvantages, according to Whalon, include the production of odors and potential discoloration of clear print

varnishes, both of which could give products a marketing disadvantage. (*Id.*) Accordingly, in at least this respect Whalon teaches away from the invention recited in claim 22.

Finally, the presently claimed invention provides unexpected results in light of the Whalon reference. Examples 1-6 of applicant's specification demonstrate outstanding preservative effects in consumable beverage compositions where the preservative composition comprises d-limonene in amounts much greater than 0.3%. In addition, these Examples describe preservative effects lasting between 30 and 70 days as compared to control beverage samples which spoiled within 4 to 14 days.

Accordingly, since Whalon, *inter alia*, (1) does not disclose, teach or suggest a preservative composition for consumable beverage products; (2) teaches away from the use of d-limonene in a range from about 0.5% to about 20%; and (3) does not suggest the above-described unexpected results, Whalon cannot anticipate or render obvious new independent claim 22.

\* \* \*

Since all of the other pending claims (i.e., 23-26) depend either directly or indirectly from independent claim 22, and therefore add at least one additional limitation to claim 22, those claims likewise cannot be anticipated or rendered obvious by Whalon. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §102(b), or in the alternative, 35 U.S.C. §103(a).

**Conclusion**

In view of the foregoing, applicant respectfully requests that the Examiner reconsider and withdraw the rejections raised in the January 16, 2007 Office Action and allow the presently pending claims, namely claims 22-26.

No fee is believed to be necessary in connection with the filing of this Amendment. If any fee is necessary, however, applicant hereby authorizes such fee to be charged to Deposit Account No. 50-0540.

If a telephone interview would be of assistance in advancing prosecution of this application, applicant's undersigned attorney encourages the Examiner to telephone him at the number provided below.

Respectfully submitted,

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/Robert E. Alderson/

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